

Amendment and Response Under 37 C.F.R. §1.111

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Serial No.: 09/014,341

Filed: January 27, 1998

For: ANTISOILING COATINGS FOR ANTIREFLECTIVE SURFACES AND METHODS OF PREPARATION

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30/46. (New) The method of claim 15 wherein the antisoiling coating composition further comprising a solvent.

Remarks

Support for new claims 45 and 46 can be found, for example, in original claim 25. Applicants appreciate that claim 25 recites a nonchlorinated solvent, and that claims 45 and 46 recite a solvent. Claims 43 and 44 having been canceled, claim 23 having been amended, and claims 45 and 46 having been added, the claims pending in the above-identified patent application are claims 1-29, 31-42, 45, and 46 (claim 30 having been previously cancelled). Applicants note with appreciation that claims 1-8, 10-22, 25-29, 31, and 35-42 have been allowed. No new matter has been added by the amendments or the new claims. Reconsideration and withdrawal of the pending rejections in light of the preceding amendments and accompanying remarks are respectfully requested.

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Rejections under 35 U.S.C. §112, First Paragraph

Claims 32-34 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner asserted on page 2 of the Office Action that the "specification as originally filed fail[ed] to provide support for R¹ as being substituted with both nitrogen and het[e]roatoms, functional groups or halogens." This rejection is respectfully traversed.

To meet the written description requirement of 35 U.S.C. §112, first paragraph, the application "must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, i.e., what is now claimed." M.P.E.P. §2163 (quoting from Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). "Such possession is effective if one of ordinary skill in the art could have

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combined the publication's description of the invention with his knowledge to make the claimed invention." Flehmg v. Giesa, 13 USPQ2d 1052, 1055 (B.P.A.I. 1989). The applicant does not have to describe the invention exactly, but it must be clear to one of ordinary skill in the art that the applicant "invented what is claimed." Vas-Cath, 935 F.2d at 1563, 19 USPQ2d at 1116.

Although no specific examples are disclosed in the specification, it is clear to one of skill in the art that "[t]he R¹ group can contain one or more heteroatoms (e.g., oxygen, nitrogen, or sulfur) or functional groups (e.g., carbonyl, amido, or sulfonamido). It can also be substituted with halogen atoms" (emphasis added), which is disclosed on page 13, lines 4-8 of the specification, conveys with reasonable clarity that the R¹ group may contain heteroatoms, functional groups, halogens, or combinations thereof. Thus, Applicants' specification clearly conveys with reasonable clarity to those of skilled in the art, as of the filing date, that Applicants were in possession of claims 32-34. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph are respectfully requested.

Rejections under 35 U.S.C. §112, Second Paragraph

Claims 9, 23, 24, 43, and 44 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claiming the subject matter which applicants regard as the invention. This rejection is respectfully traversed.

In rejecting claim 9, the Examiner asserted on page 2 and bridging onto page 3 of the Office Action that "the perfluoropolyether group having repeating units of -(C_nF_{2n})- or -(CF(Z))- can not be understood since the polymer group having these repeating units does not result in a perfluoropolyether group."

Claim 9 recites, in part, that "R_f is a perfluoropolyether group comprising perfluorinated repeating units selected from the group consisting of -(C_nF_{2n})-, -(C_nF_{2n}O)-, -(CF(Z))-, -(CF(Z)O)-, -(CF(Z)C_nF_{2n}O)-, -(C_nF_{2n}CF(Z)O)-, -(CF₂CF(Z)O)-, and combinations thereof" Applicants would like to point out the claim recites that whatever combinations of perfluorinated repeating units are utilized, they must link together to comprise a perfluoropolyether group.

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Therefore, the R_f , as recited in claim 9, is composed of repeating units that clearly result in a perfluoropolyether group. Thus, in view of Applicants specification, there is clear and sufficient guidance provided to apprise one of ordinary skill in the art the scope of the antireflective article containing a substrate having an antireflective surface and an antisoiling coating that is at least partially cured thereon according to the claimed invention.

In short, it is well recognized that a claim that is understandable to one of skill in the art and defines the subject matter that Applicant regards as the invention meets the requirements of 35 U.S.C. §112, second paragraph. All that is required by the second paragraph of section 112 is that the claims set out and circumscribe a particular area that the Applicant regards as the invention with a reasonable degree of precision and particularity. Applicants have readily defined this particular area, i.e., antireflective article comprising a substrate having an antireflective surface and an antisoiling coating that is at least partially cured thereon, such that one of skill in the art would understand all of the claim language when read in light of the specification and it is as precise as the subject matter requires.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph, are respectfully requested.

In rejecting claims 23 and 24, the Examiner stated that the phrase "the step of gravure coating" lacked an antecedent basis. Applicants traverse the rejection; however, in order to advance prosecution of the above-identified application, Applicants have amended claim 23, which claim 24 depends therefrom, thereby rendering the rejection moot.

Withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

In rejecting claims 43 and 44, the Examiner asserted that claim 43 is a duplicate of claim 1, and that claim 44 is a duplicate of claim 15. Applicants traverse the rejection; however, in

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order to advance prosecution of the above-identified application, Applicants have canceled claims 43 and 44, thereby rendering the rejection moot.

Withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Summary

In view of the above amendments and remarks, reconsideration and withdrawal of the rejections are respectfully requested. If the Examiner has any questions or concerns with respect to the present application, the Examiner is encouraged to contact the Applicants' Representative, Ann Mueting, at (612) 305-1217.

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on this 8 day of March, 2001.

Ann M. Mueting

March 8, 2001
Date

AMM/rgg/kjm

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